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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,236	08/21/2001	Johann Klein	H-3497 PCTUS	3870
423	7590	04/06/2005	EXAMINER	
HENKEL CORPORATION THE TRIAD, SUITE 200 2200 RENAISSANCE BLVD. GULPH MILLS, PA 19406			WYROZEBSKI LEE, KATARZYNA I	
			ART UNIT	PAPER NUMBER
			1714	

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/856,236

Applicant(s)

KLEIN ET AL.

Examiner

Katarzyna Wyrozewski

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-49 is/are pending in the application.
- 4a) Of the above claim(s) 33-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-32 and 42-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

In view of applicant's response filed on 1/31/2005, following office action is final as necessitated by amendment. Applicant's arguments are not persuasive, all the rejections of record are incorporated here by reference.

The examiner would like to correct the applicant's status identifiers, since claims 31 and 32 are not withdrawn. Claims 33-41 were withdrawn based on original presentation.

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 12-30, 42-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richards (US 6,229,970).

The discussion of the disclosure of the prior art of RICHARDS from paragraph 5 of the office action mailed on 11/10/2004 is incorporated here by reference.

3. Claims 12-30, 42-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richards (US 6,229,970) in view of CLEMMENS (US 5,169,617).

The discussion of the disclosure of the prior art of RICHARDS and CLEMMEND from paragraph 6 of the office action mailed on 11/10/2004 is incorporated here by reference.

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4. In the amendment filed on 1/31/2005 the applicants argued following:

a) The prior art of RICHARDS does not teach the invention at hand. The prior art of RICHARDS does not teach the particle size of WDP gypsum, since different processes formed different particle size.

With respect to the above argument, the prior art of RICHARDS clearly stated that the gypsum utilized in the disclosure can be formed by desulfurization of flue gas (col. 5). Since the applicants stated that different processes would form different particle sizes, then the flue gas desulfurization process of RICHARDS should form gypsum having particle size particular to that of flu gas desulfurization. CLEMENS further supports the examiner allegation and therefore the *prima facie* obviousness.

b) Applicant's invention shows unexpected advantage of decreased shrinkage.

Decreased shrinkage of the composition is not a limitation in the present claims.

c) Applicants submit that the office action lacks motivation and basis for conclusion.

With respect to the above argument the examiner disagrees. The motivation statement and basis for conclusion are there. The examiner further discussed *prima facie* obviousness in the argument a.

d) Even if CLEMENS shows flu gas desulfurization WDP particles having particle size of less than 200 nm, without more it does not provide motivation to combine.

CLEMENS shows particle size of gypsum that is formed by gas desulfurization process. This is also the same type of gypsum recited in the prior art of RICHARDS. Therefore the obviousness reason for the combination of RICHARDS and CLEMENS lies in the particle size of gypsum formed by flue gas desulfurization process.

e) The office action appears to employ improper "obvious to try" standard.

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With respect to the above argument, if applicants look back at the office action, the examiner never said anything in that manner. The applicants misconstrued. The examiner clearly stated that it would have been obvious to make the combination.

f) The applicants further disagree with assertion that a burden has shifted to the applicants to provide evidence that the flue gas desulfurization of the cited art would not produce particles of claimed invention.

The examiner has established *prima facie* obviousness, for utilizing gypsum formed by flue gas desulfurization having particle size as that in CLEMENS. Since RICHARDS and CLEMENS both utilize gypsum formed by flue gas desulfurization, the particle size of gypsum in RICHARDS should be the same or similar to that of CLEMENS. The applicants have yet to make their rebottle.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

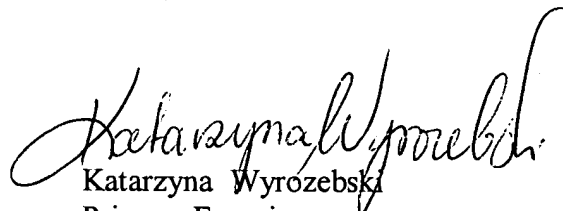
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katarzyna Wyrozebski whose telephone number is (571) 272-1127. The examiner can normally be reached on Mon-Thurs 6:30 AM-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Katarzyna Wyrozebski
Primary Examiner
Art Unit 1714

April 4, 2005